

Patent
Attorney Docket No. 032567-011

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Masahito Niikawa

Group Art Unit: 2612

Application No.: 09/291,195

Examiner: JAMES M HANNETT

Filing Date: April 14, 1999

Confirmation No.: 1785

Title: IMAGE PROCESSING SYSTEM, METHOD FOR FORMATTING RECORDING MEDIUM, AND
PROGRAM PRODUCT

AMENDMENT/REPLY TRANSMITTAL LETTER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Enclosed is a reply for the above-identified patent application.

☒ A Petition for Extension of Time is also enclosed.

☐ Terminal Disclaimer(s) and the ☐ \$65.00 (2814) ☐ \$130.00 (1814) fee per
Disclaimer due under 37 C.F.R. § 1.20(d) are also enclosed.

☐ Also enclosed is/are _____

☐ Small entity status is hereby claimed.

☐ Applicant(s) requests continued examination under 37 C.F.R. § 1.114 and enclose the
☐ \$395.00 (2801) ☐ \$790.00 (1801) fee due under 37 C.F.R. § 1.17(e).

☐ Applicant(s) requests that any previously unentered after final amendments not be entered.
Continued examination is requested based on the enclosed documents identified above.

☐ Applicant(s) previously submitted _____

_____ on _____
for which continued examination is requested.

☐ Applicant(s) requests suspension of action by the Office until at least _____,
which does not exceed three months from the filing of this RCE, in accordance with 37 C.F.R.
§ 1.103(c). The required fee under 37 C.F.R. § 1.17(i) is enclosed.

☐ A Request for Entry and Consideration of Submission under 37 C.F.R. § 1.129(a) (1809/2809) is also
enclosed.

- ☒ No additional claim fee is required.
- ☐ An additional claim fee is required, and is calculated as shown below.

AMENDED CLAIMS					
	No. of Claims	Highest No. of Claims Previously Paid For	Extra Claims	Rate	Additional Fee
Total Claims	17	MINUS 20 =	0	x \$50.00 (1202) =	\$ 0.00
Independent Claims	6	MINUS 6 =	0	x \$200.00 (1201) =	\$ 0.00
If Amendment adds multiple dependent claims, add \$360.00 (1203)					
Total Claim Amendment Fee					\$ 0.00
<input type="checkbox"/> Small Entity Status claimed - subtract 50% of Total Claim Amendment Fee					\$ 0.00
TOTAL ADDITIONAL CLAIM FEE DUE FOR THIS AMENDMENT					\$ 0.00

- ☐ A check in the amount of _____ is enclosed for the fee due.
- ☐ Charge _____ to Deposit Account No. 02-4800.
- ☐ Charge _____ to credit card. Form PTO-2038 is attached.

The Director is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17, 1.20(d) and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800. This paper is submitted in duplicate.

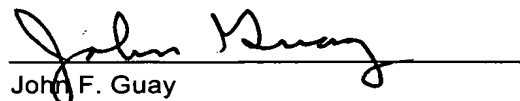
Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

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Date: December 16, 2004

By


John F. Guay
Registration No. 47,248



Patent
Attorney's Docket No. 032567-011

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)	
Masahito NIIKAWA)	Group Art Unit: 2612
Application No.: 09/291,195)	Examiner: J. Hannett
Filed: April 14, 1999)	Confirmation No.: 1785
For: IMAGE PROCESSING SYSTEM,)	
METHOD FOR FORMATTING)	
RECORDING MEDIUM, AND)	
PROGRAM PRODUCT)	

REQUEST FOR RECONSIDERATION

Commissioner for Patents
Alexandria, VA 22313-1450

Sir:

In response to the final Office Action dated August 24, 2004, Applicant respectfully requests reconsideration and withdrawal of the rejection of the claims.

Before proceeding with an analysis of the rejections, Applicant notes with appreciation the Examiner's indications in Section 5 of the Office Action that claims 10-17 are allowed and that claims 2-5, 8 and 9 contain allowable subject matter. Section 5 also includes the Examiner's statement for reasons for allowance. Applicant reserves the right to provide comments, if necessary, in response to the Examiner's statement a later time on or before payment of the Issue Fee.

Also, Applicant acknowledges the inadvertent oversight pointed out by the Examiner on page 2, lines 4-11 of the final Office Action regarding his contention that the card slot 8 of Figure 3 of Watanabe et al. allegedly discloses the claimed "controller to cause a program to be stored in the region," and not the controller 58, as was indicated in the June 1, 2004 response.

Turning now to the rejections, the Office Action maintained the rejection of claims 1, 6 and 7 under 35 U.S.C. § 102(e), as allegedly being anticipated by the Watanabe et al. publication. With respect to claim 1, the Action states that Applicant's arguments in the June 1, 2004 response, which explain why the Watanabe et al. publication fails to explicitly or inherently describe the claimed image processing apparatus processor and controller, were not considered persuasive, for the following reasons:

Furthermore, Watanabe et al. clearly states on Paragraphs [0108-0109] that the camera is controlled by the controller (58) and that the camera is driven by reading a program out of the external memory card (70). Furthermore, Watanabe et al. teaches that the image data stored in memory (19) can be processed. This processing is controlled by the control unit (58) and the control unit operates based on a program read from the memory card. Therefore, the processing of the image data in memory is performed by the controller (58). The process of storing a program in the memory card (70) to be read by the camera (1b) is viewed as creating a region in the memory accessible from the camera (emphasis added). (See, page 2, lines 12-19.)

In lines 2 to 3 of page 4, the Examiner further contends Watanabe et al. inherently describes that "*a computer* recorded the program onto the memory card." It is respectfully submitted, however, that the fact that *something* created a region in the memory 70 for the utility program does not necessarily imply such creation was by the computer 2a of Watanabe et al., much less a computer at all. Nor does the Watanabe et al. document imply anywhere that an "image processing apparatus" created the program in the context in which this feature is recited in claim 1.

As pointed out in Applicant's previous response, even if one were to assume, *arguendo*, that some computer recorded the camera utility program, any such assumption would not constitute a factual basis, within the meaning of Section 102, that the Watanabe et al. document inherently describes the combination of specific features recited in claim 1, namely, the claimed system including a photographing apparatus and an image processing apparatus to which said photographing apparatus and a recording medium can be connected, and in which the

photographing apparatus comprises a controller for *executing* a program stored in the recording medium. Such hypothetical assumption also would not necessarily disclose that the image processing apparatus includes a processor for creating a region accessible from the photographing apparatus and a controller for causing the program to be stored in this created region.

MPEP §2131 instructs that in order for a reference to anticipate a claim, the reference must show, either expressly or inherently disclosed, every feature recited in the claim. Additionally, it is the burden of the Office to present any factual basis of inherency, *i.e.*, that the above-noted deficiencies are necessarily present in the Watanabe et al. publication. MPEP §2112 is clear on this: "In relying on the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art" (emphasis added). In other words, inherency requires the characteristic or function must be present, and any conclusion of inherency must be based in fact and not speculation. See, *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1269, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). It is respectfully submitted that the Office Action failed to provide reasonable logic based in fact that the computer 2a of Watanabe alleged to be the claimed "image processing apparatus" (see, page 3, section 2, line 3) comprises a processor for creating a region accessible from a photographing apparatus and a controller for causing a program, which is executed by a controller of a photographing apparatus, to be stored in the created region.

Indeed, in the last two lines of page 2, the Action states: "Furthermore, Watanabe et al teaches that the camera with the memory card connected to it is designed in such a way that it can be connected to any arbitrary computer." It is respectfully submitted that this statement serves to further support that the "utility program" of Watanabe et al. is stored on the memory card 70 prior to *ever* being inserted into the computer 2a. Moreover, the statement of the Action at the top of page 3, purporting that the computer 2a *can* be the computer that initially stored the

program into the memory card (71) is, at best, based in conjecture and not on any factual evidence from Watanabe et al. that the computer 2a necessarily includes a processor operative to create a region accessible from the camera and a controller for causing the program to be stored in that region.

The Watanabe et al. publication, by contrast, is directed to an electronic apparatus for obtaining image pickup data in the form of a card-shaped electronic device, such as a PC card type (see paragraphs 0011-0013, 0021). According to Watanabe et al., the electronic apparatus includes a memory card 70 having a "camera utility program" resident therein before inserting the card into a computer (see, lines 2-4 of page 6). With reference to paragraph 0014 of the background description, Watanabe et al., in fact, describes that such programs in prior image pickup systems would need to be newly loaded on each computer to which the electronic device is connected unless a specific personal computer is available. Watanabe et al. attempts to address this problem by including a camera utility program within the memory card of an image pickup system, such that it can be operated by "an arbitrarily selected personal computer" (see, the paragraph 0013 with regard to memory card 70 and paragraph 0021 with respect to a dual-card configuration including memory card 71). Hence, the Watanabe et al. document actually appears to *teach away* from the computer 2a that is connected to the camera 1a initially storing the program into the memory card (71), as implied in lines 1 to 2 of page 3 of the Office Action.

For at least these reasons, it is respectfully submitted that the Examiner's conclusion of inherency is unfounded.

Additionally, Watanabe et al. fails to disclose the claimed feature that a "photographing apparatus comprises a controller for *executing* a program stored in said recording medium." In contrast, Watanabe et al. describes that the *computer* initiates the camera utility program (page 6, lines 2-3) and that the computer controls recording of an image based on the program (paragraph 0109, lines 4-5, paragraph 0011, and paragraph 0113, lines 3-6). It is respectfully submitted that one of

ordinary skill in the art would not have interpreted this description in Watanabe et al. to disclose that *the pickup unit* executes the stored utility program within any reasonable interpretation of the term "executing a program." Moreover, there is no description in Watanabe et al. of a region *created by a processor of an image processing apparatus* that is *accessible from a photographing apparatus* as recited in the context of claim 1.

For all the above reasons, Applicant submits that the Office has failed to establish a *prima facie* case of anticipation with respect to claim 1. Therefore, the rejection is unsustainable and should be withdrawn.

The rejection of claim 6 also should be withdrawn at least because Watanabe et al. fails to describe the recited photographing apparatus. For instance, the photographing apparatus recited in claim 6 includes, among other features, "an interface for reading a program *for processing the image data recorded in said memory* out of an external recording medium; and a controller for executing *the program read out from the recording medium.*" In contrast, Watanabe et al. describes that the "camera utility program" stored in the memory card 70 of is started by the computer 2a and not the control unit 58, as pointed out above. Thus, the computer 2a of Watanabe et al. system appears to execute the camera utility program. Moreover, Watanabe et al. does not mention or imply that the control unit 58 operates in any way to *execute* a program read out from the memory card 70 for processing image data.

With reference to paragraphs 0108-0109, the Examiner asserts that Watanabe et al. describes controlling the camera by the control unit 58 *and that the camera is driven by reading a program out of the external memory card 70.* (See, page 2, lines 12-14.) However, the undersigned has reviewed the paragraphs of Watanabe et al. relied upon for meeting the recitations of claim 6 and respectfully submit that its disclosure of a "camera utility program" stored in the memory card 70 does not meet the recitations of claim 6. For instance, they do not describe the claimed controller of the photographing apparatus for executing the program read

out from the external recording medium. To the contrary, the image pickup unit 1a of Watanabe et al. appears to operate as a peripheral device under the control of the computer 2a. More particularly, the pickup unit 1a receives instructions from the computer 2a initiated by way of an input device of the computer, such as a mouse or space key (see, paragraph 0111), and carries out internal processes accordingly. Hence, to the extent that Watanabe et al. describes any particulars of the "camera utility program" in the cited paragraphs, the pickup control unit 58 does not appear operative to *execute* the camera utility program stored in the memory card 70.

In lines 11-12 of section 3, the Examiner asserts, "Watanabe et al teaches that the overall control of the camera is controlled by the control unit (58)." However, the embodiment of Watanabe et al. relied upon in setting forth the rejection explicitly describes the camera utility program as being stored in the memory card 70 to enable operation of the pickup *by an arbitrarily selected personal computer* (paragraph 0113, lines 3-6). Hence, in contrast to the above assertion, the *computer* of Watanabe et al. appears to have "overall" control of the pickup unit (e.g., such as when an instruction from the driver software program executed by a computer causes a controller of a printer or other peripheral device to carry out a function). In other words, the driver software of the camera utility program is *executed by the computer 2a*, which enables the computer to transmit instructions the control unit 58 of the pickup unit 1a to perform various recording functions.

For at least these reasons, it is respectfully submitted the Watanabe publication fails to disclose the combinations of every feature recited in claim 6.

Claim 7 depends from claim 6 and, therefore, is allowable at least for the above reasons. In addition, the combination of claim 7 recites additional features not disclosed in the Watanabe et al. patent. For example, claim 7 recites that the memory is attachable to and detachable from the photographing apparatus. In Section 4 on page 4 of the Action, the Examiner alleges these features to be disclosed by the description of the memory card 70 in paragraph 0109 of Watanabe et al. However, because the Examiner has already asserted that the memory card

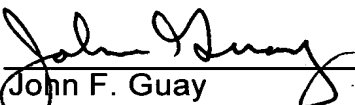
70 of Watanabe et al. to allegedly be the claimed "external recording medium," it cannot also function as the claimed "memory for recording image data" Hence, the Examiner's reading of claim 7 is inconsistent, and thus not clearly understandable.

The Watanabe et al. publication does not show all the recitations recited claims 1, 6 and 7, as the Applicant has pointed out. It is respectfully submitted that claims 1, 6 and 7 are allowable.

In light of the foregoing, reconsideration and allowance of the claims are respectfully requested. Should any other issue arise, the Examiner is invited to contact the undersigned at the number listed below.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

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Date: December 16, 2004